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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,735	12/01/2003	Gregory J. Boss	YOR920030442US1	3079
59144 7590 10/29/2008 CAHN & SAMUELS, LLP 1100 17th STREET, NW SUITE 401 WASHINGTON, DC 20036				
EXAMINER FLEISCHER, MARK A				
ART UNIT 3624		PAPER NUMBER		
MAIL DATE 10/20/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,735

Applicant(s)

BOSS ET AL.

Examiner

MARK A. FLEISCHER

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendments filed on 12 June 2008.
2. Claim 1 has been amended.
3. Claims 2–30 have been cancelled.
4. Claim 1 is currently pending and has been examined.

Response to Amendments

5. New 35 USC §101 have been added in light of recent court and board decisions as shown below. No other outstanding rejections with respect to 35 U.S.C. §112 or objections to the specification or claims exist except as noted below.

Response to Arguments

6. Applicant's arguments received on 12 June 2008 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
7. Applicant argues that a *prima facie* case of obviousness has apparently not been established. In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re*

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Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

8. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
9. To this end, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. Although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).
10. The issue of obviousness is therefore not determined by what the references expressly state, but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lal*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:
 - (i) obvious does not require absolute predictability;
 - (ii) non-preferred embodiments of prior art must also be considered; and
 - (iii) the question is not express teaching of references but what they would suggest.
11. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references.

Within *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

12. Applicant argues that Minneman does not teach or suggest "excluding the votes within a predetermined period of time before the specific storyline branch occurs" (Remarks, p.5) and further claims that while Minneman provides "a window of time in which to cast votes" this is distinct from the teaching of the invention as noted above. It appears however as if the Applicant is reading limitations into the claims from the specification. Moreover, the difference between the teachings of the Applicant and Minneman appear to be non-existent votes not cast within the specified time-window are, *ipso facto* 'excluded' within the meaning of the claims.
13. It is therefore respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).
14. Using these standards, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has successfully been satisfied, since evidence of corresponding claim elements in the prior art has been presented, and since the Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention as also suggested in the below referenced motivations. Applicant should carefully consider revising the claim language to overcome the pending rejections which may place the application in a better condition for allowance.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The preamble of independent Claim 1 is not a process, machine, manufacture, or composition of matter, or any improvement thereof wherein a process claim is sufficiently tied to another statutory class. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a §101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Examiner notes that while these claims do recite some components of the elements of another statutory class, they are insufficient to substantively tie them to another statutory class in that no correspondence is discernable between the various method steps and the particular components of the computer system.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over Minneman (US 6243740 B1) in view of Williams (US 20020178442 A1) and further in view of Chisholm (US 5400248 A).

Claim 1:

Minneman, as shown, describes and/or discloses the following limitations.

- *A method for selecting a logical branch in a storyline among a plurality of available storyline branches* (Minneman, in at least the abstract states: "The public [...] communicates, via the device or devices, a signal indicative of their reactions and for effecting a prospective scene selection in the document content that, in turn will vary the narrative." (emphasis added) where 'communicates ...indicative...for effecting' corresponds to *a method for selecting*. Minneman, in at least [0005] (column 1, lines 50-1), further describes systems and methods that "have been devised for the private direction of a narrative story through a number of alternative paths and endings [...]" (emphasis added) where 'paths' corresponds to *available storyline branches*.),
- *... by excluding the votes within a predetermined period of time before the specific storyline branch occurs* (Minneman, in at least claim 9 claims "monitoring the signals in accordance with predetermined conditions for recognizing the reaction by a predominant public interest expressed as a voting measured by the plurality of signals;" (emphasis added) and in dependent claim 11 states: "the video elements including tokens for indicating a time for the communicating of the signals." (emphasis added) where 'predetermined conditions' pertain to 'voting' and within some '[indicated time]'. Note that this voting scheme includes the exclusion capability described in Minneman [0028] (col. 8, line 55) and thereby meets the limitation.

Minneman does not specifically describe obtaining votes, *per se*, but Williams, as shown, does.

based on voters' votes (Williams, in at least [0030] states: "Two weeks later the audience votes for Ending 1." (emphasis added) where 'audience votes' corresponds to *voters' votes.*), *comprising*:

- *accumulating the votes from the voters* (Williams, in at least [0007]: states: "Audience feedback that influences programming content may be collected directly from weekly audience polling [...]" (emphasis added) which corresponds to the limitation.);
- *selectively excluding votes for a specific storyline branch* (Minneman, in at least [0028] (col. 8, line 55) states: "Alternative embodiments of the invention include directional voting, wherein custom antennas with directional qualities will attend to signals coming from one set of viewers whilst rejecting signals from another." (emphasis added) where 'rejecting signals from another' corresponds to *selectively excluding*. Note also that in Minneman in at least [0008] (col. 2, line 10), reference is specifically made to story branches, hence, the aforementioned 'rejecting ... from another' corresponds to effectuating changes in the storyline by possibly excluding certain voters' votes.);
- *selecting a winning tally that corresponds to a storyline branch, based on the total of the accumulated votes* (Williams, in at least [0023-30] states: "Two days later, the audience answers are tallied and the most popular answers are [...]" Two weeks later the audience votes for Ending 1." (emphasis added) where 'are tallied' corresponds to *accumulated votes* and 'most popular' corresponds to *selecting a winning tally...* and 'audience votes for Ending 1' corresponds to the winning *storyline branch*.);
- *transferring the storyline branch to a content branching system* (Williams, in at least [0021] states: "[T]he [Online Request] is storyline-content that originates within the audience's imagination and then later is culled and incorporated by the staff into the show's storyline." (emphasis added) where 'storyline-content' corresponds to

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storyline branch and 'culled ... by the staff' corresponds to a *content branching system* that manages the storyline branch.); and

- *displaying the transferred storyline branch* (Williams, in at least [0006]: states: "[T]he invention queries will be prescribed to directly determine the show's story line [...]" (emphasis added) where 'show's story line' corresponds to *displaying* ... See also Williams claim 1.).

Minneman's and Williams' inventions both pertain to utilizing audience participation in modifying the evolution of a storyline. Williams' invention also indicates some inventory of scenes for later use. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Minneman and Williams to create a more interactive, and efficient system as this affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors and further, that the technical ability existed at the time of the invention to improve upon the prior art in the same way and that such improvement was predictable.

Neither Minneman nor Williams, specifically describe and/or disclose the following limitations, but Chisholm, in an analogous art does.

- *determining if the votes are weighted, wherein if the votes are weighted, selectively multiplying the votes by respective weight factors, said weight factors being proportional to graduated ticket pricing* (Chisholm, in claims 38 and 39 claim a method where "determining which voter input signals were most critical in obtaining a prescribed set of results; [...] determining which voter input signals were least critical in obtaining a prescribed set of results [...]" (emphasis added) where the noted criticality corresponds to a weighting. Note that Chisholm also specifically mentions weighted voting as in [0017]: "Votes need not be weighted equally," and further in [0011] that "the vote administrator weights voter x's vote by the factor $W(x)$..." where

- the 'administrator', *ipso facto*, *determines* whether a particular vote is to be weighted.);
- *determining if additional votes remain to be accumulated, wherein if additional votes remain to be accumulated, repeating an accumulation of the votes until all the votes have been incremented* (Chisholm, in at least [0066] states: "Then the system passes through the list again and evaluates all new votes [...] This process is repeated until an iteration occurs on which no new votes are determined. If all votes in the group have been determined by this process (step I), the system is finished and the results are displayed." (emphasis added) where 'the system' in 'repeating a process' corresponds to *repeating an accumulation*. Also, Chisholm claim 12 specifically refers to *accumulating* where "controller means, coupled to said computer system and said plurality of voting units, for accepting or rejecting additional voter input signals [...]" (emphasis added) where the 'controller means' that '[accepts] or [rejects] additional voter [] signals' corresponds to adding additional votes.);
 - *calculating a total for the accumulated votes* (this is inherent in 'audience polling', *i.e.*, the very notion of 'polling' and 'voting' directly implies tallying or summing or counting votes).

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of Minneman/Williams with that of Chisholm to describe a flexible system that allows management of audience choices and how they are to be weighted because it creates a more interactive system and affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors and further, that the technical ability existed at the time of the invention to improve upon the prior art in the same way and that such improvement was predictable.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Mark A. Fleischer** whose telephone number is **571.270.3925**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Bradley Bayat** whose telephone number is **571.272.6704** may be contacted.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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/Mark A Fleischer/
Examiner, Art Unit 3624 14 October 2008

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624

